

REMARKS

Upon entry of the present amendment, claims 1-5 will remain pending in the above-identified application with claims 1-2 and 4-5 standing ready for further action on the merits and claim 3 remaining withdrawn from consideration based upon an earlier Restriction Requirement of the Examiner. Claim 1 has been amended and claims 4-5 added.

The present amendment to claim 1 does not introduce new matter into the application as originally filed. Support for the amendment to claim 1 occurs at pages 14 and 21 of the present specification. Claim 4 is based on amended claim 1, but does not positively recite (c-2) or (c-3) therein. Claim 5 is based on claim 2, but depends from newly added claim 4.

Enclosed 37 CFR § 1.132 Declaration

A 37 CFR § 1.132 declaration of Mr. Yoshihiro YOMOGIDA, one of the instant inventors, is enclosed with the instant reply. The Examiner is respectfully requested to review Mr. YOMOGIDA's enclosed declaration at this time, as it contains therein comparative testing results. In this regard, remarks at page 3 of Mr. YOMOGIDA's enclosed declaration include the following:

The test results show evidently slimy feel-preventing results. It is excellent by using both 2-hexylmonoglyceryl ether and magnesium.

In Composition B not containing GE-2EH, the slimy feel-preventing result by adding magnesium chloride for the catching feel stopped at the content of 0.5%. The catching feel was not sufficiently obtained.

Composition A, on the other hand, containing GE-2H, was found to have an excellent catching feel just by incorporation of GE-2H. The catching feel was evidently increased with addition of magnesium chloride hexahydrate.

It can be said that, according to the test results, a synergistic combination of GE-2EH with magnesium chloride (Mg ion) increases a good feel in use (catching feel) during washing. (emphasis added)

Explanation of Claimed Invention

The claimed invention is characterized by containing components (c) and (e) in combination and is eventually provided with a synergistic advantage in view of prevention of slimy feel.

This advantage is supported by additional test data shown in the declaration submitted herewith. The tests were carried out by the combination of (c-1) GE-2EH (*i.e.*, 2-ethylhexyl monoglyceryl ether) with (e) magnesium chloride (Mg ion).

Claim Rejections Under 37 CFR § 103(a)

Claims 1-2 have been rejected under the provisions of 35 USC § 103(a) as being unpatentable over **Miyajima et al. EP '761** (EP 1 092 761).

Claims 1-2 have been rejected under the provisions of 35 USC § 103(a) as being unpatentable over **Kazunari et al. JP '993** (JP 2001019993).

Reconsideration and withdrawal of each of these rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the

importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 127 SCt 1727, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art

to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Accordingly, while the courts have adopted a more flexible teaching, suggestion, motivation (TSM) test in connection with the obviousness standard based on the *KSR v. Teleflex* case, which case involved a mechanical device in a relatively predictable technological area, it remains true that, despite this altered standard, the courts recognize inventors face additional barriers in relatively unpredictable technological areas as noted in *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007).

Further, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

Distinctions Over the Cited Art

Miyajima et al. EP ‘761

Miyajima et al. EP ‘761 discloses a shampoo composition containing 2-ethylhexyl monoglyceryl ether. However, it does not disclose any example of using 2-ethylhexyl monoglyceryl ether in combination with amineoxide.

A good detergency is obtained by using the (a) component of the invention, *i.e.*, an anionic surfactant, and the (b) component of the invention, *i.e.*, an amineoxide surfactant. This is

because component (a) and component (b) make a complex and improve the detergency of oils. However, this on the other hand, causes a slimy-feel when the combination of an anionic surfactant and an amineoxide surfactant is used on a hard surface such as on dishes used for eating.

The present invention solves this encountered problem of “slimy-feel” and thereby provides a valuable improvement in the art by also incorporating the combination of components (c) and (e) into the inventive detergent compositions.

In particular, in the claimed invention, incorporating magnesium (*i.e.*, component (e)) is essential and distinguishes the claimed invention from Miyajima et al. EP ‘761, by providing an improvement in “slimy-feel” prevention.

Kazunari et al. JP ‘993

A mechanical English translation of Kazunari et al. JP ‘993 obtained from the Japanese Patent Office (JPO) is attached hereto. The Examiner is respectfully requested to make the same of record in the file of this application by citing the same on a PTO-892 form.

Kazunari et al. JP ‘993 may describe a carbon atom number that can correspond to 2-ethylhexyl monoglyceryl ether, but it nonetheless does not describe the specific structure of a 2-ethylhexyl group.

Moreover, as evident in the examples of the present invention (*e.g.*, see Table 1 at page 30), octyl monoglyceryl ether, which possesses the same carbon atom number of the alkyl group as that of 2-ethylhexyl group monoglyceryl ether, and another alkyl monoglyceryl ether that has a different carbon atom number in the alkyl were tested. Of the tested compositions, the composition containing 2-ethylhexyl monoglyceryl ether possessed the most excellent property

of “slimy-feel” prevention. This result evidences an unexpected improvement in the art, which in no way would have been expected by one of ordinary skill in the art.

As indicated above, a signed 37 CFR § 1.132 declaration of Mr. Yomogida (one of the instant inventors) is attached hereto and contains comparative test results therein that are material to a consideration of the non-obviousness of the instant invention.

Composition A in the declaration contains 2-ethylhexyl monoglyceryl ether, but Composition B does not contain it. Composition A and Composition B also include a plurality of compositions, respectively, with changed concentrations of magnesium as shown in Figures 1 and 7 of Mr. Yomogida enclosed declaration (*each Figure is reproduced below for the Examiner's convenience*).

Fig. 1

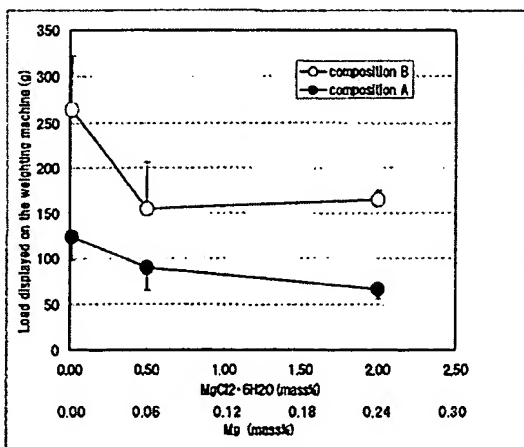


Table 7

Formulation ingredients (mass%)	Composition A	composition B
(a) ES-I	27.0	27.0
(b) AO-I	5.0	5.0
(c) GE-2EH	3.0	—
(e) Magnesium chloride hexahydrate (NOTE)	0.01~2.0 (0.001~0.24)	0.01~2.0 (0.001~0.24)
(f) Nonion-II	3.0	3.0
(g) p-TS	2.5	2.5
(h) Ethanol	5.0	5.0
(i) PG	5.0	5.0
(d) Ion-exchanged water	balance	balance
Total	100	100
PH	6.6	6.6

(NOTE) Numerals in each parenthesis show a concentration (mass%) as magnesium in the composition.

In conclusion, the Examiner's attention is again directed to the following remarks at page 3 of Mr. YOMOGIDA's enclosed declaration:

The test results show evidently slimy feel-preventing results. It is excellent by using both 2-hexylmonoglyceryl ether and magnesium.

In Composition B not containing GE-2EH, the slimy feel-preventing result by adding magnesium chloride for the catching feel stopped at the content of 0.5%. The catching feel was not sufficiently obtained.

Composition A, on the other hand, containing GE-2H, was found to have an excellent catching feel just by incorporation of GE-2H. The catching feel was evidently increased with addition of magnesium chloride hexahydrate.

It can be said that, according to the test results, a synergistic combination of GE-2EH with magnesium chloride (Mg ion) increases a good feel in use (catching feel) during washing. (emphasis added)

CONCLUSION

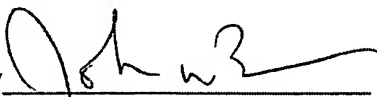
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-2 and 4-5 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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Attachments: Mechanical English translation of Kazunari et al. JP 2001019993 obtained from the Japanese Patent Office (JPO).

37 CFR § 1.132 Declaration of Mr. Yoshihiro YOMOGIDA